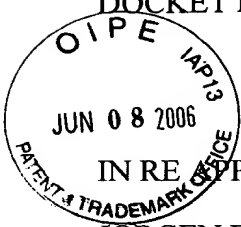


DOCKET NO: 213854US2PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

JORGEN BJORKNER, ET AL.

SERIAL NO: 09/926,221

FILED: JANUARY 15, 2002

FOR: PERSONAL COMMUNICATION
ON COMPUTER NETWORKS

:

: EXAMINER: SHAW, PELING ANDY

:

: GROUP ART UNIT: 2144

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheet. No more than five (5) pages are provided.

I am the attorney or agent or record.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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Raymond F. Cardillo, Jr.
Registration No. 40,440

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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

In the February 8, 2006 Office Action, Claims 31 and 58 were objected to; Claims 31-36, 38-43, 47, 48, 50-54, and 56-60 were rejected under 35 U.S.C. §102(e) as anticipated by England (U.S. Patent No. 6,144,991); Claims 37, 44, 46, and 49 were rejected under 35 U.S.C. §103(a) as unpatentable over England in view of Tang et al. (U.S. Patent No. 5,793,365, herein "Tang"); and Claim 45 was rejected under 35 U.S.C. §103(a) as unpatentable over England in view of Kakuta et al. (U.S. Patent No. 6,714,965, hereinafter Kakuta).

The May 24, 2006 Advisory Action indicated that the Amendment filed under 37 C.F.R. §1.116 would be entered for purposes of appeal, and upheld the rejections of Claims 31-54 and 56-60 under 35 U.S.C. §§102(e) and 103(a). The Advisory Action did not address the objection to Claims 31 and 58 in light of the Amendment filed on May 5, 2006.

In response to the rejection of Claim 31 under 35 U.S.C. §102(e) as anticipated by England, Applicants respectfully traverse the outstanding ground of rejection. Claim 31 recites, *inter alia*,

...a first terminal configured to...***acquire a client program from a management unit***... said management unit is configured to access a database and ***determine what world is associated with the internet address of the first information site***....

England does not teach or suggest at least these elements of Claim 31. England describes a system where a guide and a client can interact in real-time.¹ The client is a user of a computer in a browser-based telecommunications network who sends messages to the guide, receives messages from the guide, and receives web pages and/or Internet resources from the guide. The guide is a user of a computer in the telecommunications network who leads the client by sending messages and/or propagating web pages to the client.² As shown in Figures 9 and 10 of England, the client and the guide may view a web page for AdaptX and use collaborative tools (described in column 8 of England) to communicate while viewing the AdaptX web page.³

England describes an element called the system server or piper server, which acts as an intermediary between the guide and the client.⁴ The February 8, 2006 Office Action appears to equate England's piper server to the claimed "management unit." Applicants respectfully traverse this position.

England describes that the client system acquires a client side component 904, which may be an applet. However, England does not teach or suggest that the applet is acquired from the piper server. England states that "[t]he applet is downloaded (i.e. transfers from the Web server to the user's PC system) with the HTML of the Web page when a Web page is

¹ England, in the Abstract.

² England, column 10, lines 41-52.

³ See, e.g., column 12, lines 57-65, and column 13, lines 7-9.

⁴ England, column 11, lines 23-25.

requested by the user. Once the applet is downloaded, it is activated and runs on the user's PC system.”⁵ However, England does not teach or suggest that the client downloads the applet from the piper server. England's teachings of “when the applet is downloaded, it will contact piper server 502 and establish a communications link that will be used to accept instructions to load Web page, Internet Resources, and collaborative tools,”⁶ does not mean that the applet is download from the piper server 502.

Rather, client web browser 1312 issues a request to HTTP server 1204 to load the client-side component 904 (i.e., the applet).⁷ However, HTTP server 1204 does not equate to the claimed management unit because the HTTP server does not “access a database and determine what world is associated with the internet address of the first information site,” as the claimed “management unit” does.

Furthermore, the piper server does not “access a database and determine what world is associated with the internet address of the first information site,” as the claimed “management unit” does. The outstanding Office Action relies on England's column 28, lines 50-60 to describe the claimed “management unit configured to access a database and determine what world is associated with the internet address of the first information site.” However, the previously-noted portion of England merely describes that the piper server maintains a database of sessions and keeps track of clients participating in the sessions.

The May, 24 Advisory Action asserts that England does describe Applicants' above claimed features and points to England from column 11, line 2 to column 12, line 52. However, these passages in England confirm that the above features are not taught or suggested by England. England clearly explains that a client initiates a request from a Web page at a HTTP server 1204, and that a Web page including a graphical frame set 902 and the

⁵ England, column 4, lines 18-22.

⁶ England, column 7, lines 36-42.

⁷ England, column 17, lines 25-28.

client-side component 904 has been loaded.⁸ Loading a web page from a HTTP server, as taught by England, *is not* acquiring a client program from a management unit, as claimed by Applicants.

Regarding Applicants' claimed management unit, the Advisory Action asserts that England "is certainly using a session database to 'keep track' of clients' participating [sic, in] the session," without pointing out how this is relevant to determining "what world is associated with the internet address of the first information site" as claimed.

As explained in Applicants' specification "[a] 'world' is a multiple of web pages that persons with interests in common can be expected to visit. A 'world' can for instance be constituted by web pages that are associated to the same server, deal with the same field of interest, or belong to the same organization."⁹ The specification also describes "world" as being a term meaning a "[l]imited amount of 'related' information sites, for instance web pages."¹⁰

As explained in MPEP §2111.02 (III), Applicants may be their own lexicographer, and MPEP §2111.01(III) states "...the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification." With respect to the claim term "world," the specification definitions do not permit the U.S.P.T.O. to interpret this term to be simply a record of clients participating in sessions.

Thus, in view of the definition of "world" provided in the specification, England's disclosure that the piper server maintains a database of sessions and keeps track of clients participating in the sessions¹¹ does not teach or suggest a "management unit configure to access a database and determine what world is associated with the internet address of the first information site," as recited in independent Claim 31.

⁸ England, column 12, lines 1-7, and lines 30-36, and in corresponding Figures 6-9.

⁹ Specification, page 3, lines 20-24, and page 11, lines 1-10.

¹⁰ Specification, page 6, lines 25-26.

¹¹ England, for example at column 29, lines 24-37.

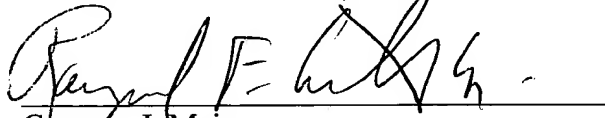
In view of the above-noted distinctions, Applicants respectfully submit that Claim 31 (and Claims 32-46 dependent thereon) patentably defines over England. Furthermore, Claim 47, although of a different statutory class, is similar to Claim 31. Applicants respectfully submit that Claim 47 (and Claims 48-54 and 56-60 dependent thereon) patentably define over England, for at least the reasons stated for Claim 31.

Furthermore, Applicants respectfully submit that Tang and Kakuta do not cure the above-noted deficiencies in England. Tang at best describes a chat room, not the above noted "management unit" or its function. Kukuta simply teaches a server 4 including a user database. Again, this is not a teaching of the above-noted "management unit" or its function.

Based on the above-noted deficiencies in the outstanding rejections, Applicants respectfully request that these rejections be withdrawn.

Respectfully submitted,

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